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Frank Venegas JR.

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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte FRANK VENEGAS JR.

Appeal 2008-4354
Application 09/597,318
Technology Center 3600

Decided: September 25, 2008

Before DONALD E. ADAMS, ERIC GRIMES, and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a post cover, which the Examiner has rejected as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

DISCUSSION

1. CLAIMS

Claims 8-12 are pending and on appeal. Claims 8 and 12 are representative and read as follows:

8. A cover for a post extending upwardly from a ground surface, the cover consisting of:

an elongated, generally cylindrical plastic sleeve having an open lower end and a closed, hemispherically shaped upper end; and

the sleeve having a consistent wall thickness including the hemispherically shaped upper end, and an interior diameter in the range of 3 to 8 inches.

12. The cover of claim 8, the sleeve further including an additive to resist ultraviolet deterioration.

2. REJECTION OF CLAIMS 8-11

Claims 8-11 stand rejected under 35 U.S.C. § 103(a) as obvious in view of Beatty¹ and Arth² (Answer 4). The Examiner finds that Beatty discloses a post cover that meets all the limitations of claim 8 (*id.* at 4-5) except that it “does not specifically define the closed upper end of the sleeve of the cover specifically having a hemispherical shape” (*id.* at 5). The Examiner finds that Arth teaches a post cover having “a closed and hemispherical shaped upper end” (*id.*).

The Examiner concludes that it would have been obvious to modify Beatty’s cover by making “the closed upper end of the sleeve . . . in a

¹ Beatty, U.S. Patent 4,516,756, issued May 14, 1985.

² Arth, Jr., U.S. Patent, 5,299,883, issued April 5, 1994.

hemispherical shape as taught by Arth, Jr. for providing a deformable and cushionable protection over the post and providing a printed and smooth surface with obvious variations of pleasing appearances” (*id.* at 6).

We agree with the Examiner’s findings and conclusion.

Appellant argues that the Examiner has not shown that it would have been obvious to combine the references because “*neither Appellant nor the prior art articulates any need for ‘deformable’ or ‘cushionable’ protection*” (Reply Br. 2). Appellant also argues that because the top of Beatty’s cover is “*conformal* to flat cuts made at the top of a post, there is nothing obvious about the conversion of a flat top to a hemispherical top” (Appeal Br. 5; Reply Br. 2).

This argument is unpersuasive. Arth teaches that its post cover “is made from a resilient, deformable and cushionable material” (Arth, col. 2, ll. 28-29). While Arth does not attribute the “deformable” or “cushionable” property to the shape of the top of its post cover, Arth does show that it was known in the art to cover a flat-topped post with a post cover having a hemispherical, closed upper end (*see* Arth, Fig. 2).

“[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious,” the relevant question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007). We agree with the Examiner that modifying Beatty’s post cover to have a hemispherical upper end would have been nothing more than the predictable use of known elements according to their established functions, and therefore obvious.

Appellant also argues that the transitional phrase “consisting of,” as used in claim 8, excludes any element not recited in the claim (Appeal Br. 3; Reply Br. 2), and “the combination [of Beatty and Arth] includes other essential components, namely, the strap 12 and interlocking inner flared lip of Arth, Jr. Accordingly, *prima facie* obviousness has not been established.” (Appeal Br. 5; Reply Br. 2.)

This argument is also unpersuasive. The Examiner’s reasoning is based on modifying the top of Beatty’s post cover to have the shape of the top of Arth’s post cover, not combining all the elements of the two post covers. *Cf. Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983)(“Claims may be obvious in view of a combination of references, even if the features of one reference cannot be substituted physically into the structure of the other reference. . . . What matters in the § 103 nonobviousness determination is whether a person of ordinary skill in the art, having all of the teachings of the references before him, is able to produce the structure defined by the claim.”).

For the reasons discussed above, we agree with the Examiner that the disclosures of Beatty and Arth would have made obvious the post cover defined by instant claim 8. We affirm the rejection of claim 8 as obvious in view of Beatty and Arth. Claims 9-11 fall with claim 8 because they were not argued separately. 37 C.F.R. § 41.37(c)(1)(vii).

3. REJECTION OF CLAIM 12

Claim 12 stands rejected under 35 U.S.C. § 103(a) as obvious in view of Beatty, Arth, and Finger³ (Answer 7). The Examiner relies on Beatty and Arth for the teachings discussed above and finds that Finger teaches a post cover “made of a plastic such as polyethylene being treated by coating[,] dipping or spraying or given a treatment with an additive of an ozone resistant material for resisting ultra violet deterioration (see col. 5, ll. 15-17)” (Answer 7).

The Examiner concludes that it would have been obvious “to modify the cover of Beatty as modified by Arth, Jr. being made of polymeric plastic as choice of material with suitable treatment of an additive to resist the ultraviolet deterioration” (*id.*).

We agree with the Examiner’s reasoning and conclusion. Each of the post covers in the cited references are made of similar materials. *See* Beatty, col. 1, l. 55 (“synthetic plastic material”); Arth, col. 3, ll. 28-29 (“polypropylene, . . . ABS, polyethylene, PVC”); and Finger, col. 5, ll. 10-11 (“polyvinyl chloride, polyethylene and polypropylene”).

Finger teaches that its post cover “may be treated by coating, dipping or spraying with an ozone resistant material and may be given treatment for protection against ultra violet rays” (Finger, col. 5, ll. 15-17). Those of ordinary skill in the art would have recognized that the post cover suggested by Beatty and Arth would also be exposed to ultraviolet rays and, being made of materials similar to Finger’s post cover, would also benefit from treatment for protection from ultraviolet rays. We therefore agree with the

³ Finger et al., U.S. Patent 3,319,328, issued May 16, 1967.

Examiner's conclusion that the post cover of instant claim 12 would have been obvious in view of the cited references.

Appellant argues that "Finger discloses *a coating* as opposed to *an additive*. . . . Thus, even if the Examiner's proposed combination were justified, Appellant's invention would not result." (Appeal Br. 6; Reply Br. 3.)

This argument is not persuasive. Claim 12 recites "an additive to resist ultraviolet deterioration," but it does not require that the additive be distributed throughout the material that forms the post cover, or contain any other limitation that would distinguish the recited additive from the treatment disclosed by Finger. Appellant has pointed to no definition of "additive" in the Specification that would limit it to those added via a certain method of manufacture or would otherwise distinguish "an additive" from a treatment applied by coating, dipping, or spraying.

"[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). We conclude that the broadest reasonable interpretation of the "additive" recited in claim 12 encompasses the treatment for ultraviolet protection taught by Finger, and therefore the product of claim 12 would have been obvious in view of the cited references. The rejection of claim 12 is affirmed.

SUMMARY

We affirm the rejection of claims 8-11 under 35 U.S.C. § 103 based on Beatty and Arth, and the rejection of claim 12 under 35 U.S.C. § 103 based on Beatty, Arth, and Finger.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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